

Application No.: 09/759986

Case No.: 52355US014

Remarks

Claims 1-24 and 31-35 are pending.

Double Patenting

The Examiner has maintained the rejection of Claims 1-24 and 31-35 under the judicially created doctrine of double patenting. Applicant respectfully continues to defer the rejection until patentable subject matter is allowed.

§ 103 Rejections

Claims 1-24 and 31-35 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Number 5,679,435 to Andriash ("Andriash") in view of U.S. Patent Number 5,902,435 to Meis ("Meis.")

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The Examiner states that Andriash teaches a graphic article meeting the limitations of the present claims. However, the Examiner admits that Andriash fails to teach that the cover film is located between two adhesive layers. The Examiner then directs the Applicant to Meis, which teaches a backing or cover layer between two adhesive layers. However, as stated above, there must be some suggestion or motivation to modify the reference or to combine the teachings. Even if the references, as combined by the Examiner, meet all the claim limitations, no motivation exists to make such a combination.

Andriash teaches a graphic article having a clear adhesive layer (13), a retro-reflective sheet (12) and a dark adhesive (15). A clear protective layer (19) is then laminated to the dark

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adhesive layer. The clear protective layer seals the structure from dirt and permits the article to be cleaned without getting cleaning solutions into the perforations. The article is then applied to a window via the clear adhesive. See Col. 5, line 51 to Col. 6, line 12.

The Examiner suggests that one of skill in the art would be motivated to modify Andriash to make the clear protective layer have two adhesive layers. However, such a modification would leave an adhesive layer exposed when the article is applied to a window. No such motivation exists. In fact, such a modification would not allow the protective layer to be effectively cleaned, as detailed in Andriash.

Additionally, even if one would be motivated to modify the protective layer of Andriash, one of skill in the art would not look to Meis. Andriash is a vision control panel for a window. While Meis is directed to a substrate for optical fibers. In order to rely on a reference under 35 USC § 103, the reference must be analogous art. MPEP § 2141.01(a). Meis is non-analogous to the present invention and to Andriash.

The rejection of claims 1-24 and 31-35 under 35 USC § 103(a) as being unpatentable over Andriash in view of Meis has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-24 and 31-35, as amended, at an early date is solicited.

Respectfully submitted,

May 20, 2004
Date

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